

REMARKS

The Office Action mailed October 19, 2005, has been received and reviewed. Claims 1 through 23 are currently pending in the application. Claims 1 through 23 stand rejected. No claims are amended herein.

Rejection of Claims based on a Defective Reissue Declaration

The Examiner has rejected claims 1 through 23 as being based on a defective reissue declaration. More specifically, the Examiner states that the declaration filed with this reissue application is defective because the errors which are relied upon to support the reissue application are not errors upon which a reissue can be based. Pointing to both the reissue declaration and to Applicants' statements in the Preliminary Amendment filed on August 1, 2003, the Examiner states that only antecedent basis errors and textual errors are being corrected, which errors do not affect the scope of the claims. Applicants respectfully traverse the Examiner's rejection.

Applicants note that the Reissue Declaration filed with this application list "other errors" as a basis for filing the application. Additionally, as set forth in the Preliminary Amendment filed on August 1, 2003, Applicant has stated that, in addition to improving antecedent basis in certain claims, claims "1-23 have been amended to rephrase apparatus limitations as affirmative method limitations or acts." Applicants submit that the various amendments to improve antecedent basis in the claims as well as the amendments to rephrase apparatus limitations as affirmative method acts, such that any potential ambiguity regarding such limitations is removed, provides sufficient basis for filing the present reissue application.

As noted by the Court of Customs and Patent Appeals (CCPA) in *In re Altenpohl*, 500 F.2d 1151 at 1156 (CCPA, 1974), "[l]ack of antecedent basis in a claim could render it invalid under 35 U.S.C. § 112, second paragraph, and correction of such a defect by reissue should not have to depend on difference in scope of the claim." Moreover, "[i]nasmuch as 35 U.S.C. § 251 is a remedial provision, which should be liberally construed, a patentee should be allowed to correct an error or ambiguity in a claim without having to rely on implication or litigation." (*Id.* at 1156-1157).

Additionally, it is noted that potential ambiguities in claims, particularly when method and apparatus limitations are intermixed in a given claim, may render a claim invalid. (*See IPXL Holdings LLC v. Amazon.com Inc.*, 72 USPQ2d 1469 (E.D. Va, 2004). Specifically, the Court stated the following:

Under 35 U.S.C. §112(2), a claim must “particularly point[] out and distinctly claim[] the subject matter which the applicant regards as his invention.” Furthermore, 35 U.S.C. §101 defines the various classes of subject matter eligible for patenting. As interpreted by the courts, apparatuses (which includes “systems”) and processes (or “methods”) are both classes of patent eligible subject matter under 35 U.S.C. §101 and may both be claimed in the same patent. This occurs, for example, in patents that claim both an apparatus and a method of using the apparatus. Such patents contain separate sets of claims ...directed towards the two different classes of invention. However, “combining two separate statutory classes of invention *in a single claim* is not sufficiently precise to provide competitors with an accurate determination of the ‘metes and bounds’ of protection involved.” *Ex parte Lyell*, No. 89-0461, 1990 WL 354583, at *5 (Bd. Pat. App. &Inter. Apr. 9, 1990) (emphasis added). Consequently, an invention “which purports to be both an apparatus and a process *in a single claim*, is ambiguous and properly rejected” as indefinite under 35 U.S.C. §112(2). *Id.* at *6 (emphasis added).

As such, Applicants submit that the errors being corrected as set forth in the Preliminary Amendment filed August 1, 2003, provide a proper basis for the present reissue application and are properly supported by the Declaration filed therewith.

Applicants, therefore, respectfully request reconsideration and allowance of claims 1 through 23.

Supplemental Reissue Declaration

Because, as shown hereinabove, Applicants believe that the Reissue Declaration is not defective, and because no claims have been amended herein, a Supplemental Reissue Declaration is not being provided herewith.

CONCLUSION

Claims 1 through 23 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, the Examiner is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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